



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/812,865	03/21/2001	James D. Grady	033042-001	1183

28977 7590 08/17/2004
MORGAN, LEWIS & BOCKIUS LLP
1701 MARKET STREET
PHILADELPHIA, PA 19103-2921

EXAMINER

LEE, PHILIP C

ART UNIT PAPER NUMBER

2154

DATE MAILED: 08/17/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/812,865

Applicant(s)

GRADY ET AL.

Examiner

Philip C Lee

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 March 2001.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-84 is/are pending in the application.
- 4a) Of the above claim(s) 32-84 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☐ Claim(s) _____ is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☒ Claim(s) 32-84 are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☒ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

DETAILED ACTION

1. Claims 1-31 are presented for examination.
2. Restriction to one of the following inventions is required under 35 U.S.C. 121:
 - I. Claims 1-31, Group I, drawn to a method for retrieving a electronic document from a code contained in physical document, classified in class 709, subclass 200.
 - II. Claims 32-49, Group II, drawn to a method of creating an electronic document, classified in class 715, subclass 513.
 - III. Claims 50-55, Group III, drawn to a method of indexing an electronic document in database, classified in class 707, subclass 1.
 - IV. Claims 56-63, Group IV, drawn to a method of processing annotation of an electronic document, classified in class 715, subclass 512.
 - V. Claims 64-72 and 76-84, Group V, drawn to a method of sharing electronic documents, classified in class 709, subclass 217.
 - VI. Claims 73-75, Group VI, drawn to a method of editing and updating an electronic document, classified in class 715, subclass 531.
3. Inventions I, II, III, IV, V and VI are related as subcombinations disclosed as usable together in a single combination. The subcombinations are distinct from each other if they are shown to be separately usable. In the instant case, inventions II-VI have separate utility such as creating, indexing, processing, sharing and updating an electronic document; this is a patentable

distinct feature not found in invention I. See MPEP § 806.05(d).

4. Because these inventions are distinct for the reasons given above and search for Groups II-VI are not required for Group I, restriction for examination purposes as indicated is proper.

5. During a telephone conversation with Alison Weisberg (registration # 45206) on July 20th, 2004 an election was made without traverse to prosecute the invention of Group I, claims 1-31. Affirmation of this election must be made by applicants in replying to this Office action. Claims 31-84 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

6. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

a. The inventors' signatures are omitted

7. It is noted that although the present application does contain line numbers in the specification and claims, the line numbers in the claims do not correspond to the preferred format. The preferred format is to number each line of every claim, with each claim beginning with line 1. For ease of reference by both the Examiner and Applicant all future correspondence should include the recommended line numbering.

Claim Rejections – 35 USC 103

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-8, 10-17 and 19-30 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz et al, U.S. Patent 5,978,773 (hereinafter Hudetz) in view of Durst et al, U.S. Patent 6,108,656 (hereinafter Durst).

10. As per claim 1, Hudetz taught the invention substantially as claimed for transmitting a code contained in an articles of commerce from a client computer to a server to retrieve an electronic version of the articles of commerce from the server, comprising:

client software residing on the client computer operative to receive and transmit a code relating to a articles of commerce to a server connected to a client computer by way of a network (col. 3, lines 25-37; figs. 1 and 5; col. 8, lines 11-col. 9, lines 20; col. 9, lines 54-58);

a database accessible by the server for retrieving an electronic address of the electronic version of the articles of commerce by relating the code to the electronic address (col. 3, lines 25-37; col. 7, lines 1-20; figs. 1 and 5; col. 8, lines 11-col. 9, lines 20); and server software residing on the server operable to receive the code transmitted by the client software via the network and retrieve from the database an electronic address of the electronic version of the articles of commerce related to the code (col. 3, lines 25-37; col. 7, lines 1-20; figs. 1 and 5; col. 8, lines 11-col. 9, lines 20).

11. Hudetz did not specifically detailing the article of commerce as a physical document. Durst taught the system for transmitting a code contained in a physical document to retrieve the electronic version of the physical document (col. 6, lines 46-53).

12. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Hudetz and Durst because Durst's system for retrieving an electronic version of a physical documents would increase the efficiency of Hudetz's system by allowing a user to easily access the document at a later date, without searching through massive amounts of files (col. 6, lines 39-40).

13. As per claim 22, Hudetz taught the invention substantially as claimed for managing electronic versions of articles of commerce comprising the steps of:

mapping a code to an electronic address of an electronic version of an articles of commerce (col. 3, lines 30-32; col. 8, lines 17-19);

acquiring a code relating to an articles of commerce (col. 3, lines 32-34; col. 8, lines 11-17);

finding the electronic address of an electronic version of the articles of commerce relating to the code (col. 3, lines 35-36; col. 8, lines 17-19);

transmitting the electronic address to a user (col. 8, lines 17-20; col. 9, lines 54-57);

maintaining the electronic version of the articles of commerce (col. 5, lines 55-58); and

using the code as a proxy to the electronic version of the articles of commerce (col. 3, lines 35-37; col. 9, lines 57-58).

14. Hudetz did not specifically detailing the article of commerce as a physical document. Durst taught the system for transmitting a code contained in a physical document to retrieve the electronic version of the physical document (col. 6, lines 46-53).

15. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Hudetz and Durst because Durst's system for retrieving an electronic version of a physical documents would increase the efficiency of Hudetz's system by allowing a user to easily access the document at a later date, without searching through massive amounts of files (col. 6, lines 39-40).

16. As per claim 2, Hudetz and Durst taught the invention substantially as claimed in claim 1 above. Durst further taught wherein the electronic version of the physical document is stored in

a network location accessible to the server and is managed by the client software (col. 6, lines 46-53).

17. As per claim 3, Hudetz and Durst taught the invention substantially as claimed in claim 1 above. Hudetz further taught wherein the client software is further configured to retrieve an electronic version of the physical document from the electronic address provided by the server software (col. 9, lines 14-21, 54-62).

18. As per claim 4, Hudetz and Durst taught the invention substantially as claimed in claim 1 above. Hudetz further taught wherein the code is a barcode (fig. 3; col. 5, lines 23-28; col. 6, lines 61-62).

19. As per claim 5, Hudetz further taught wherein the code is a legible numeric code (fig. 3; col. 3, lines 27-30).

20. As per claim 6, Hudetz and Durst taught the invention substantially as claimed in claim 1 above. Hudetz and Durst did not specifically detailing the types of network. However, Hudetz taught other types of wide area networks and systems could be practiced with the invention (col. 9, lines 22-29). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include different types of network because by doing so would increase the field of use for their systems.

21. As per claims 7-8 and 10-14, Hudetz and Durst taught the invention substantially as claimed in claim 1 above. Hudetz further taught comprising a device for acquiring the code (col. 5, lines 3-5, 22-29; element 44, fig. 1).

22. As per claim 15, Hudetz and Durst taught the invention substantially as claimed in claim 1 above. Hudetz further taught wherein the database resides on the server (col. 7, lines 43-54).

23. As per claims 16 and 17, Hudetz and Durst taught the invention substantially as claimed in claim 1 above. Hudetz and Durst did not specifically detailing the types of system for the client software. However, Hudetz taught other types of wide area networks and systems could be practiced with the invention (col. 9, lines 22-29). It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include different types of systems because by doing so would increase the field of use for their systems.

24. As per claim 19, Hudetz and Durst taught the invention substantially as claimed in claim 1 above. Durst further taught wherein the server software is configured to track metrics of users (col. 5, lines 62-col. 6, lines 2).

25. As per claim 20, Hudetz and Durst taught the invention substantially as claimed in claim 19 above. Durst further taught wherein the server software is configured to update user profiles according to the user metrics (col. 5, lines 62-col. 6, lines 2).

26. As per claim 21, Hudetz and Durst taught the invention substantially as claimed in claim 2 above. Hudetz and Durst did not teach sharing of electronic document. "Official Notice" is taken for the concept of a user viewing, sharing, and sending the electronic version of the physical document is known and accepted in the art. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to include a user sharing the electronic document because by doing so would increase the user's control of an electronic document.

27. As per claims 23-28, Hudetz and Durst taught the invention substantially as claimed in claim 22 above. Hudetz further taught the steps of transferring and processing the document code, and the steps of finding and transmitting the electronic address to a client computer (col. 3, lines 25-37; col. 7, lines 1-20; figs. 1 and 5; col. 8, lines 11-col. 9, lines 20; col. 9, lines 54-57).

28. As per claim 29, Hudetz and Durst taught the invention substantially as claimed in claim 22 above. Hudetz further taught wherein the electronic address comprises a URL (col. 3, lines 30-32).

29. As per claim 30, Hudetz and Durst taught the invention substantially as claimed in claim 22 above. Durst further taught wherein the electronic address transmitted to a user is stored in a user account (col. 5, lines 62-col. 6, lines 2; col. 6, lines 19-22).

30. Claim 9 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz and Durst in view of Want et al, U.S. Patent 6,122,520 (hereinafter Want).

31. As per claim 9, Hudetz and Durst taught the invention substantially as claimed in claim 8 above. Hudetz and Durst did not teach a personal digital assistant. Want taught wherein the data input device comprises a personal digital assistant (PDA) (col. 2, lines 38-41).

32. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Hudetz, Durst and Want because Want's teaching of a personal digital assistant would increase the field of use in their systems.

33. Claim 18 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz and Durst in view of Stork et al, U.S. Patent 5,781,914 (hereinafter Stork).

34. As per claim 18, Hudetz and Durst taught the invention substantially as claimed in claim 1 above. Hudetz and Durst did not teach processing the electronic documents on the basis of keywords. Stork taught wherein the server software is further configured to process electronic documents on the basis of keywords and meta information (col. 5, lines 1-30).

35. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Hudetz, Durst and Stork because Stork's method of processing electronic documents on the basis of keywords would increase the

efficiency of Hudetz's and Durst's systems by allowing retrieval of electronic documents based on the matching of keywords.

36. Claim 31 is rejected under 35 U.S.C. 103(a) as being unpatentable over Hudetz and Durst in view of Aggarwal et al, U.S. Patent 6,611,834 (hereinafter Aggarwal).

37. As per claim 31, Hudetz and Durst taught the invention substantially as claimed in claim 30 above. Hudetz and Durst did not teach customized organization of user account. Aggarwal taught wherein the user account allows for customized organization of each electronic address stored in the user account (col. 4, lines 25-46).

38. It would have been obvious to one having ordinary skill in the art at the time of the invention was made to combine the teachings of Hudetz, Durst and Aggarwal because Aggarwal's system of customized organization would increase the user's flexibility of Hudetz's and Durst's systems by allowing the user to organization the stored data according to their preferences.

39. A shortened statutory period for reply to this Office action is set to expire THREE MONTHS from the mailing date of this action.

40. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Philip C Lee whose telephone number is (703)305-7721. The

Art Unit: 2154

examiner can normally be reached on 8 AM TO 5:30 PM Monday to Thursday and every other Friday.

41. If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee can be reached on (703)305-8498. The fax phone number for the organization where this application or proceeding is assigned is (703)872-9306.

42. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)350-6121.

P.L.



**JOHN FOLLANSBEE
SUPERVISORY PATENT EXAMINER
TECHNOLOGY CENTER 2100**